

Appl. No. : 09/690,366
Filed : July 25, 2001

REMARKS

The following remarks are supplemental to the remarks contained in the amendment filed February 23, 2005 in response to the Office Action dated November 23, 2004. The entire contents of the amendment filed February 23, 2005 are incorporated herein by reference. Thus, Applicants submit is not necessary to restate the status of the claims. However, for completeness, Claims 1 and 9-16 remain pending in the present application.

RESPONSE TO REQUEST FOR INFORMATION UNDER 37 C.F.R. § 1.105

The Outstanding Request for Information under 37 C.F.R. § 1.105 Is Untimely

Further to the Applicants' objection set forth in the amendment filed February 23, 2005, Applicants further submit that the outstanding request for information under 37 C.F.R. § 1.105 is sufficiently untimely that it should be withdrawn. Applicants submit that it has long been established that "a request for information should not be made with or after a final rejection." M.P.E.P. § 704.11(b). Rather, the M.P.E.P. indicates that a requirement for information "should be made at the earliest opportunity after the necessity is recognized." *Id.*

In the present application, the Examiner has now issued five (5) Office Actions (one previous Office Action having been sent by Examiner Colianni), as well as two separate forms PTO-892. Thus, it appears that the Examiner has conducted at least two searches; more than enough time to come to the realization that more information is needed. Additionally, the Examiner has issued several final Office Actions in the present application, some of which have been withdrawn. Finally, Applicants submit that because the present application has been in the process of examination before the present Examiner for over a year, during which five Office Actions have been submitted, it is wholly unreasonable to issue a request for information at this time. Thus, Applicants respectfully request that the request for information under 37 C.F.R. § 1.105 be withdrawn.

The Outstanding Request for Information under 37 C.F.R. § 1.105 Has Not Been Issued In the Proper Format and Should Be Withdraw

Applicants also respectfully request the outstanding request for information under 37 C.F.R. § 1.105 to be withdrawn because it has been submitted in an improper format. Applicants submit that it has long been established that any paper that is to become a permanent

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part of the United States Patent and Trademark Office records in the file of a patent application must comply with 37 C.F.R. § 1.52(a)(1)(ii) which requires each sheet to have a left-side margin of "at least one inch." The paper attached to the outstanding Office Action, which includes the request for information, has a margin that is clearly less than one inch and thus should not be made part of the permanent Patent and Trademark Office records for this patent application. Thus, Applicants submit that the present request for information should be withdrawn and a proper paper be issued if the Examiner maintains his position that the request for information is proper. Further, if any such additional request for information is issued, the accompanying Office Action should not be made final, in accordance with MPEP § 704.11(b).

Supplemental Remarks Regarding U.S. Patent No. 4,048,290 Included with Information Disclosure Statement Filed on February 23, 2005

With respect to the Examiner's request for "at least one document which shows creating metallic particles by flame hydrolysis and at least one document which shows the creation of composite powders by flame hydrolysis," Applicants have submitted U.S. Patent No. 4,048,290 in the Information Disclosure Statement submitted with the amendment filed February 23, 2005. Applicants submit that the 4,048,290 patent completely satisfies this particular requirement.

Applicants note that the Information Disclosure Statement filed on February 23, 2005 did not include a copy of the 4,048,290 patent. Rather, current U.S. Patent Office procedure does not require copies of U.S. patents to be submitted with Information Disclosure Statements, including a 1449 listing such a U.S. patent. However, as a courtesy to the Examiner and for the Examiner's convenience, Applicants have included herewith a copy of U.S. Patent No. 4,048,290.

With regard to the subject matter identified by the Examiner in the request under 37 C.F.R. § 1.105, Applicants note that the 4,048,290 patent discloses processes used for "the production of finely-divided metal and metalloid oxides by flame hydrolysis." See Abstract of U.S. Patent No. 4,048,290. Applicants also wish to point out that the term "finely-divided" used in the specification of the 4,048,290 patent refers to "particles." In support of this proposition,

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Applicants respectfully direct the Examiner to col. 1, line 42 – col. 2, line 3 in which the 4,048,290 patent discloses:

The finely-divided metal or metalloid oxide products producible by flame hydrolysis of corresponding metal or metalloid halide feedstocks are useful in various applications. For instance, finely-divided titania, vanadia and zirconia find utility as fillers and pigments in diverse polymers and elastomers and as catalysts and catalyst supports. Finely-divided antimony oxide is useful as a flame retardant when dispersed in polymeric materials. Finely-divided alumina is useful as a filler for various matrices and finds additional utility as an anti-static and anti-soil agent when applied to textiles and as a frictionizing or anti-slip agent when applied to paper products or to textile fibers prior to spinning thereof. Coformed oxides produced by way of the flame hydrolysis process, such as silica/alumina or titania/alumina also find utility in catalytic applications.

Finely-divided silica products presently represent the preponderance of the metal or metalloid oxides commercially produced by flame hydrolysis. These silica products are characterized by their relatively high purity, amorphous crystal structure, small particle size and tendency to form gel-like networks when dispersed in various organic liquids. The flame hydrolysis silicas are used as reinforcing fillers in elastomers, particularly silicone elastomers; as rheology control and thickening agents in organic liquids; as flow and sag control agents in caulk, sealant and adhesive compositions, as anti-blocking agents for plastics and rubbers and adhesive coatings, and as free flow agents in various powdered products.

(Emphasis added)

Applicants submit that the description set forth above, and in particular, the bolded terms, clearly refer to the use of flame hydrolysis for forming metallic particles and composite powders. Thus, the 4,048,290 patent satisfies the outstanding requirement.

Completeness of Reply

To the extent that the Examiner believes that the reply to the outstanding request for information under 37 C.F.R. § 1.105 is not complete because an item such as a document or an explanation of the relevance of the document is missing, Applicants submit that such item is unknown or is not readily available. Thus, Applicants submit that the cumulative responses set forth in the present Supplemental Response and in the Amendment filed February 23, 2005 fully comply with the outstanding request for information under 37 C.F.R. § 1.105.

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**DENIAL OF ENTRY OF THE PRESENT
SUPPLEMENTAL RESPONSE IS INAPPROPRIATE**

Applicants submit that the present Supplemental Response is proper under 37 C.F.R. § 1.111(a)(2). Applicants submit that it has long been established that disapproving a supplemental response is inappropriate if either:

(A) the Examiner has NOT devoted a significant amount of time on the preparation of an Office Action before the Amendment or Reply is received in the Office (i.e., the 37 C.F.R. § 1.6 receipt date of the Amendment or Reply); or

(B) the entry of the Amendment or Reply would NOT require significant additional time in the preparation of the Office Action.

M.P.E.P. § 714.03(a) ¶IV.

Applicants submit that the present Supplemental Response, having been filed by facsimile, will be received and forwarded to the Examiner before or at about the same time as the Amendment filed February 23, 2005 (which was filed by regular mail). Thus, Applicants submit that it would be clearly inappropriate to disapprove the entry of the present Supplemental Response.

Request For Telephone Interview

In view of the forgoing, the present Application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, Applicants' undersigned attorney of record hereby formally requests a telephone interview with the Examiner. Applicants respectfully request the Examiner to call the undersigned attorney of record at 949-721-6384 (direct) or at the general office number listed below.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 2/24/05

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